



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/543,125      | 04/05/2000  | Brett T. Hannigan    | 60154               | 7024             |

23735 7590 07/03/2003

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

**Notification of Non-Compliance  
With 37 CFR 1.192(c)**

Application No.

09/543,125

Applicant(s)

HANNIGAN, BRETT T.

Examiner

Daniel A Hess

Art Unit

2876

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 16 May 2003 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192 (c) within the longest of any of the following three **TIME PERIODS**: (1) **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer; (2) **TWO MONTHS** from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. **EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☐ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☒ A single ground of rejection has been applied to two or more claims in this application, and
  - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
  - (b) ☒ the brief includes the statement required by 37 CFR 1.192(c) (7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☐ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet



Continuation of 9. Other (including any explanation in support of the above items): In section VII, the applicant states that each of the claims is independently patentable, and does not group claims such that they stand and fall together. However, in the appeal brief of 5/16/2003, the applicant groups at least some claims together, suggesting that in fact they would stand and fall together. Grouping the various claims is required.

The examiner would like to take this opportunity to point out that certain claims currently stand objected to. The examiner notes that as the MPEP makes clear ( 1214.06 II. ),

"If the board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency on claim 1 and independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or ex parte reexamination certificate with claim 3 only."

In other words, the applicant stands to lose those claims which were previously objected to if those claims remain in dependent form and the rejection for the corresponding independent claim is affirmed by the board..



THIEN M. LE  
PRIMARY EXAMINER

BEST AVAILABLE COPY